

**IV. Remarks:**

Claims 7-14 are pending in this application. Claims 1-6 and 16-33 have been previously cancelled.

Claims 7-11, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Patent No. 5,739,597) in view of Odaohara (U.S. Patent No. 5,969,438). Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Patent No. 5,739,597) in view of Odaohara (U.S. Patent No. 5,969,438) in further view of Kim (U.S. Patent No. 5,814,977).

These rejections are respectfully traversed on the grounds that these references are defective in establishing a prima facie case of obviousness.

**All Claim Limitations Must Be Considered:**

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.

The Applicant respectfully asserts that the rejection ***does not factually support*** a prima facie case of obviousness. Therefore, the Applicant is under no obligation to submit evidence of nonobviousness. The rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, the PTO provides in MPEP § 2143 that:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Therefore, with respect to claim 7, to sustain this rejection the combination of Bailey and Odaohara must contain all of the above claimed elements of the claim.

However, neither reference teaches a means responsive to application of a first voltage *at the first input* to an apparatus having a power supply.

The Examiner admits that “Bailey does not disclose means responsive to application of a first voltage at a first input of the adapter card.” However, the Examiner asserts that Odaohara “discloses means responsive to application of a first voltage at a first input (at adapter 20) to an apparatus having a power supply unit that can switch between internal and external power sources.” The Applicant respectfully disagrees with this assertion. Although the adapter 20 of Odaohara is called an “internal AC adapter,” the adapter 20 is “exchangeably accommodated, for instance, into the media bay of the PC 100 and is electrically connected to the body of the PC 100 through connectors 21a and 21b.” (Odaohara col. 1, line 67 – col. 2, lines 7) Thus, although physically located with the casing of the notebook PC, the adapter 20 is external to the circuit of the Notebook PC 100. Consequently, the adapter 20 is not “at a first input of the adapter card” as claimed in claim 7.

Furthermore, the adapter 20 does not contain “means responsive to application of a first voltage at a first input of the adapter card for . . . preventing a second voltage applied at a second input of the adapter card from being used as the main power supply,” as claimed in claim 7. The adapter 20 only contains a detecting circuit which cooperates with a switching circuit 50. (Odaohara col. 3, line 17-19). So, the adapter alone cannot be a means for “preventing a second voltage applied at a second input.” On the other hand, if it is assumed that the adapter 20 and the switching circuit act in combination to form the means for “preventing a second voltage,” these elements are not “at a first input of the adapter card.” Thus, Odaohara does not disclose “a means responsive to application of a first voltage at a first input of the adapter card,” as claimed in claim 7.

In this context, 35 U.S.C. §103 provides that:

A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2s 1596 (Fed. Cir. 1988), because *inter alia*, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Because all the limitations of claim 7 have not been met by the referenced patents, it is impossible to render the subject matter as a whole obvious. Thus, the explicit terms of the statutes have not been met and the Office Action has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

#### **No Motivation to Combine:**

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re*

*Geiger*, the court stated in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)

The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See *e.g.*, *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

The Office Action does not provide motivation for the combination. Furthermore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection because none of the patents teach or even suggest the desirability of the combination.

The MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

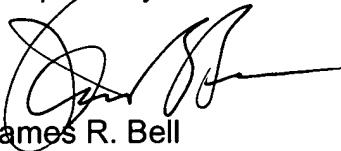
Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference of the combination.

Therefore, independent claim 7 and the claims dependent therefrom are submitted to be allowable.

### Conclusion

As a result of the foregoing, it is respectfully asserted that all the claims in the Application are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,



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